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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,544	12/11/2003	Kermit B. Bohning	1388-027/63349	2691

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DOW AGROSCIENCES LLC  
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EXAMINER
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IBRAHIM, MEDINA AHMED

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/735,544	<b>Applicant(s)</b> BOHNING, KERMIT B.	
	<b>Examiner</b> Medina A. Ibrahim	<b>Art Unit</b> 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 11-25 and 27-33 is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-33 are pending and are under consideration.

#### ***Claim Objections***

Claims 1, 7 and 26-27 are objected to for reciting incomplete ATCC accession information. The claims should be amended to recite the accession information as appropriate.

#### ***Objection to the specification***

The specification is objected to for reciting incomplete deposit accession information on page 38. The deposit statement in the specification must be amended to include the deposit accession number. The specification is also objected to for the inclusion of "-----" on page 38.

### **REQUIREMENT OF ALLOWANCE UNDER 37 CFR 1.801-1.809**

The Deposit Statement in the specification on page 38, is deemed in accordance with 37 CFR 1.801-1.809. Applicant is reminded that once the deposit of seed has been made, information regarding the date of deposit, description of the deposited material including number of seeds deposited, name and address of the depository, and the accession number must be added to the specification in order to comply with 37 CFR 1.809(d). In addition, the claims must be amended to replace the arbitrary designation "PTA-\_\_\_\_\_" with the appropriate Accession Number.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claim is directed to a corn plant or part thereof having all the physiological and morphological characteristics of the inbred line BE9514. However, neither the seed nor the plant of inbred corn line BE9514 is reproducible. This is the reason why a deposit of the seed of the inbred line BE9514 is required in order for the claimed inbred line to meet the requirement under 112, 1<sup>st</sup> paragraph. The specification provides guidance only for corn plants produced from the seed of the inbred line BE9514. Therefore, a corn plant or part thereof not produced from the seed of the inbred line BE9514 is not reproducible, absent evidence to the contrary. Therefore the claim is not enabled.

#### ***Written Description***

Claims 9-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention lacks written description under the current written description guidelines. The claims are drawn to hybrid plants and seed produced by

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crossing the inbred corn line BE9514 with unidentified corn lines. These are genus claims.

Applicant only describes inbred corn line BE9514 having specific combination of genotypic and phenotypic characteristics that distinguish the line from other corn lines. Applicant has not described the morphological and/or genotypic characteristics for all hybrid corn plants and seeds produced by crossing the inbred corn line BE9514 with another unidentified corn plant. No specific morphological or genotypic characteristics that distinguish the claimed hybrid corn plants/seeds from other corn plants and seeds are described. Furthermore, since Applicant has not described the breeding partners involved in crossing with the exemplified plant, or the resultant product.

The Federal Circuit court stated that a written description of an invention "requires a precise definition, such as by structure, formula [or] chemical name, of the claimed subject matter sufficient to distinguish it from other material". *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398 (Fed. Cir. 1997). The court also stated "naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of is not a description of that material". *Id.* Further, the court stated that to adequately describe a claimed genus, Applicant must describe a representative number of the species of the claimed genus, and that one of skill in the art should be able to "visualize or recognize the identity of members of the genus". *Id.* In the instant application, the disclosure of a single corn inbred line, BE9514, does not provide adequate written description for the claimed genus, any and all F1 plant/seed,

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wherein only one parent plant is known to be BE9514, and the rest of the parents are unknown. Accordingly, the written description requirement is not satisfied.

***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kramer (US Pat. 5, 929, 313, filed March 1998).

Claims are drawn to F1 hybrid corn plants/seeds produced by crossing the inbred corn line BE9514 with unidentified corn plants.

Kramer teaches F1 hybrid seed and plant produced by crossing a yellow dent inbred maize line designated as PHMJ2 with another maize plant. The reference teaches maize breeding methods such as pedigree and recurrent selection and

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backcrossing methods to transfer specific desirable trait between plants. The claims do not recite specific morphological and/or physiological characteristics that would distinguish the claimed seed and plant from those of the prior art. The corn plants of the instant invention and those of the prior art share plant morphological characteristics such as dark green leaf, white cob color, similar ear and kernel morphology, and agronomic characteristics. Since Applicant has not disclosed specific morphological and physiological characteristics for the claimed F1 hybrid/seeds, the claimed plants are indistinguishable from those of the prior art, especially since the second parent plants involved in the crossing are unknown.

Alternatively, if the claimed progeny plants, and seeds produced from BE9514 are not identical to PHMJ2, then it appears that they differ from the PHMJ2 plants and seeds due to minor morphological variation, wherein said minor morphological variation would be expected to occur upon cultivation of said plants on different soil types with different nutrient supplements and under different environmental growth conditions such as temperature, humidity, light, etc. in different progeny of the same cultivar, and wherein said minor morphological variation would not confer a patentable distinction to PHMJ2.

Since Applicant has not disclosed specific morphological and/or physiological characteristics for the claimed hybrid plants /seeds, the claimed plants are deemed to be anticipated by or obvious over the PHMJ2 plants/seeds of the prior art, especially since the second parent plants involved in the crossing are unknown. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim

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may be properly rejected over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products.

Therefore, the claimed invention is anticipated by or, in the alternative, is obvious over the prior art, absent evidence to the contrary.

**Remarks**

Claims 1-8, 11-25, and 27-33 are allowable.

**Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM. Before and after final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

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Mai

MEDINA A. IBRAHIM  
PRIMARY EXAMINER

